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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/389,399	02/16/95	JOHNSON	L 215778

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TUCKER EXAMINER

ART UNIT PAPER NUMBER

3309

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DATE MAILED:

02/28/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/398,399

Applicant(s)

Johnson

Examiner

Guy Tucker

Group Art Unit

3309



Responsive to communication(s) filed on _____.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) 9-13 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-8 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on Nov 17, 1995 is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-8, drawn to an instrument for forming a centered bore, classified in Class 606, subclass 79.

Group II. Claims 9-13, drawn to a method of forming a centered bore, classified in Class 606, subclass 79.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (M.P.E.P. § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process, such as measuring the diameter of a bore.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kevin Joyce on 1-16-96 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-8. Affirmation of this election must be made by applicant in responding to this Office action. Claims 9-13

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have been withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

The disclosure is objected to because of the following informalities: 1) on page 5 lines 1-4, it is unclear how the length of the handle is related to leverage as stated; there is no torque or moment being applied, 2) the "diameter of 10 mm" on page 7 line 5 is not understood since $d=10$ mm (see figure 2). Appropriate correction is required.

The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the embodiment of claim 6 must be shown or the feature cancelled from the claim. No new matter should be entered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 4-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Davis (5,190,548). Davis discloses an instrument for forming a bore comprising a handle (unshown chuck attached to 22), a rod (12), and a means for engaging (34). Note that the intended use of the claimed device has been considered but does not serve to structurally distinguish the claim over the applied reference. Regarding claim 2, see figure 2.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

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A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claim 3 is rejected under 35 U.S.C. § 103 as being unpatentable over Davis (5,190,548) in view of Borzone et al (5,122,134). Davis discloses the invention substantially as claimed as discussed above. However, Davis does not disclose semi-elliptical fins. Borzone et al teaches semi-elliptical fins in the same field of endeavor for the purpose of efficient cutting (see column 2 lines 4 and 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Borzone et al, to make the fins of Davis semi-elliptical in order to make the cutting more efficient.

The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. Ellis and Spranza III disclose indicia on rods with fins. The balance of the references show centering devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Guy Tucker at telephone number (703) 308-3271. Examiner Tucker can normally be reached on Monday through Thursday from 7:00 AM to 5:30 PM, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, examiner Tucker's supervisor, Steve Pellegrino, can be reached at (703) 308-0871. The fax number for Group

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3300 is (703) 305-3590 or 3591.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 3300 receptionist at (703) 308-0858.

GVT
February 20, 1996

Guy V. Kucher
CONTRACTOR
PRACTICE MANAGER
GROUP 3300